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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,684	01/14/2000	Takenori Idehara	325772014000	7340
7590 04/15/2008				
Barry E. Bretschneider Morrison & Foerster LLP 1650 Tysons Blvd. Suite 300 McLean, VA 22102			EXAMINER BRINICH, STEPHEN M	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 04/15/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/482,684

**Applicant(s)**

IDEHARA, TAKENORI

**Examiner**

STEPHEN M. BRINICH

**Art Unit**

2625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16 is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/IC)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09482684	1/14/00	IDEHARA, TAKENORI	325772014000

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**EXAMINER**

STEPHEN M. BRINICH

**ART UNIT****PAPER**

2625

20080331

DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

Commissioner for Patents

/Stephen M Brinich/  
Primary Examiner, Art Unit 2625

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwabuchi (JP 10-044524).

Re claims 1-3 & 5, Iwabuchi discloses (Figures 4-5, paragraphs 0068-0076) a method and means of processing image data. The system receives first image data (page description language data input via IF 301; paragraph 0068), stores it in a memory 3021 (paragraph 0069), and develops it into second image data via image generating section 302 (bitmap data; paragraph 0069). The result is compressed into third image data and stored in memory 306 (paragraph 0074).

Re claims 1-3 & 5, Iwabuchi further discloses another embodiment that includes the making of a comparison to determine whether this compression increases the original data amount (paragraph 0075) and to selectively skip compression in the case where compression increases the data amount (thus, the smaller of the original data or the compressed data is obtained). The final image data (the smaller of the original data or the compressed data) is stored in a memory 306 (paragraph 0071).

Re the recitation of "the storage unit", the combination of memories 3021 and 306 of Iwabuchi is readable on this "storage unit" (except for the recitations of storing both the original and compressed image data, then discarding one of them, which are addressed below).

Iwabuchi does not disclose an embodiment in which both the first (i.e. original) image data and the third (i.e. compressed) image data are stored in a storage unit, and the larger of the original data and the compressed data is discarded and the smaller of the two is retained.

In the first embodiment (in which both the original image data and the compressed image data are stored), it would have been obvious to one of ordinary skill in the art at the time the invention was made to discarded one of them (since they both represent the same image, making one of them redundant), and to select (using the selection arrangement taught in the second embodiment) the larger of the two to be discarded.

The motivation to do so would be to make memory available for other uses (e.g. storing the next incoming image data). Specifically, the motivation for selecting the larger of the two for discarding would be to maximize the amount of memory so freed.

Therefore, it would have been obvious to combine the first and second embodiments of Iwabuchi to obtain the invention as specified in claims 1-3 & 5.

Re claim 4, in any case in which the Iwabuchi system provides its output to a printer (described as a standard configuration, Figure 1 and paragraphs 0001 & 0100) and is used to print more than one copy of a document (as in the situation described in paragraphs 0007 & 0052-0054), each will be printed seriatim using the stored data generated by the above described arrangement.

Re claim 6, some type of data connection means is inherently required to transmit image data to an external printer (paragraph 0001). This output to this data connection means is readable upon the (not further described) recited "transmitter", and the data connection means itself is readable upon the (not further described) recited "network".

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iwabuchi as applied to claim 3 above, and further in view of Applicant's Background Prior Art.

As described above, some type of data connection means is inherently required to transmit image data to an external printer (paragraph 0001). This output to this data connection means is readable upon the (not further described) recited

"transmitter", and the data connection means itself is readable upon the (not further described) recited "network".

Iwabuchi does not disclose expressly a detector for detecting problems during printing through a network and a transmitter for transmitting the stored image data when such a problem is detected.

Applicant's Background Prior Art discloses (page 5, lines 7-13) a response to a malfunction (which must inherently be detected in order for such a response to occur) while printing over a network. This response includes transferring (i.e. transmitting) the stored image data to a printer different from the malfunctioning one.

Iwabuchi and Applicant's Background Prior Art are combinable because they are from the field of image data processing for printer output.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the malfunction response of Applicant's Background Prior Art in conjunction with the Iwabuchi printer system.

The suggestion/motivation for doing so would have been to enable a print job to continue after a malfunction.

Therefore, it would have been obvious to combine Iwabuchi with Applicant's Background Prior Art to obtain the invention as specified in claim 7.

***Allowable Subject Matter***

4. Claims 14-16 are allowed.
5. The following is a statement of reasons for the indication of allowable subject matter:

Re claims 14 & 16, the art of record does not teach or suggest the recited first comparator for comparing the development time for developing the first image data into the second image data with the printing time for printing the second image data and the recited second comparator for comparing the volume of the first (initial) and third (final) image data in conjunction with the recited image processing arrangement.

Re claim 15, the art of record does not teach or suggest the recited comparator for comparing a time required for developing the recited first image data of the current page and a time required for printing using the recited second image data of the two previous pages in conjunction with the recited image processing arrangement.

***Response to Arguments***

6. Applicant's arguments filed 1/10/08 have been fully considered but they are not persuasive.



Applicant correctly points out (1/10/08 Remarks: page 2, line 7 - page 3, line 16, particularly page 3, lines 2-16) that Iwabuchi differs from the present claimed invention in that Iwabuchi fails to disclose discarding the larger of the first (original) and third (compressed) data. In response to the outstanding Office Action argument that this element would be obvious to one of ordinary skill in the art, Applicant argues that Iwabuchi preserves the first data because it is used again, and that if it were obvious to one of ordinary skill in the art to modify Iwabuchi to delete the larger of these two data items, Iwabuchi would have done so.

Re the argument that Iwabuchi uses the first data again, Examiner notes that the first and third data are representations of the same original image. Thus, either of these may be used, and the other deleted, while maintaining the function of the device. It is recognized that the deletion of the first data cannot simply be bodily incorporated into Iwabuchi without provision for using the third data instead. However, the test for obviousness is not whether features may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to

those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Applicant argues (1/10/08 Remarks: page 3, lines 17-21) that the argument that it would be obvious to discard the larger of the first and third image data relies upon hindsight.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

#### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor David Moore can be contacted at 571-272-7437.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

Art Unit: 2625

Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

/S. M. B./

Primary Examiner, Art Unit 2625

/Thomas D Lee/

Primary Examiner, Technology Division 2625